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FROM : Oleg F. Kaplun, Esq. of Fay Kaplun & Marcin, LLP
DATE : June 26, 2006
SUBJECT : US Patent Appln. Serial No. 09/588,037
for *System for Consumer Transaction Information*
that *Follows the Consumer*
Our Ref.: 40116/05504

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Attorney Docket No. 40116/05504 (A-68146)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s) : Stout
Serial No. : 09/588,037
Filing Date : June 5, 2000
For : System for Consumer-Transaction Information that Follows the Consumer
Group Art Unit: : 3626
Examiner : Vivek D. Koppikar

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By: 
Oleg F. Kaplun, (Reg. No. 45,559)

Date: June 26, 2006

TRANSMITTAL

In support to the Notice of Appeal filed April 26, 2006 transmitted herewith please find an Appeal Brief for filing in the above-identified application. Please charge the Credit Card of Fay Kaplun & Marcin, LLP in the amount of \$500.00 (PTO-Form 2038 is enclosed herewith). The Commissioner is hereby authorized to charge the **Deposit Account of Fay Kaplun & Marcin, LLP NO. 50-1492** for any additional required fees. A copy of this paper is enclosed for that purpose.

Respectfully submitted,

Dated: June 26, 2006

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PATENT

Attorney Docket No.: 40116 - 05504

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
J. Gregory STOUT)
Serial No.: 09/588,037) Group Art Unit: 3626
Filed: June 5, 2000) Examiner: Vivek D. Koppikar
For: SYSTEM FOR CONSUMER-) Board of Patent Appeals and
TRANSACTION INFORMATION) Interferences
THAT FOLLOWS THE CONSUMER)

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APPEAL BRIEF UNDER 37 C.F.R. § 1.192

In support of the Notice of Appeal filed April 26, 2006, and pursuant to 37 C.F.R. § 1.192, appellants present their appeal brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 30-49 in the final Office Action dated January 17, 2006. The appealed claims are set forth in the attached Claims Appendix.

1. **Real Party in Interest**

This application is assigned to Symbol Technologies, Inc., the real party in interest.

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2. Related Appeals and Interferences

There are no other appeals or interferences which would directly affect, be directly affected, or have a bearing on the instant appeal.

3. Status of the Claims

Claims 30-49 have been rejected in the final Office Action and are the subject of the present appeal.

4. Status of Amendments

An amendment was submitted on March 14, 2006, but was not entered by the Examiner. For the purposes of this appeal, the claims stand as listed in the attached claims appendix and as referenced in the final Office Action dated January 17, 2006.

5. Summary of Claimed Subject Matter

The present invention comprises systems and methods for storing and retrieving consumer-transaction information. (See Specification, page 6, lines 8-9). The subject matter of independent claim 37 comprises a point-of sale (POS) system 126 that identifies a consumer to a data farm 140 including a unique identification record for the consumer by, for example, using a data capture device to capture the consumer's identification data at a merchant location where the consumer presents an instrument (e.g., a credit, debit or loyalty card, etc.) during a transaction. (Id. at page 8, lines 22-26). The data farm 140 selects from one of a plurality of content (e.g., coupon offers) based on transaction data such as the items the consumer is purchasing. (Id. at

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page 9, lines 3-13). The one of the offers is then displayed on a display device which receives the one of the offers from the data farm 140 and displays the one of the offers to the consumer. (Id. at page 9, lines 15-18). The offer display device receives an indication of acceptance of the offer and forwards the indication to the data farm 140. (Id. at page 9, lines 19-20). The data farm 140 then stores the indication of acceptance in the unique identification record corresponding to the customer. (Id. at page 9, lines 24-28).

The subject matter of independent claim 30 comprises a method including the steps of identifying a consumer using a data capture device at a first merchant location where the consumer presents an instrument during a processing of a first transaction at the first merchant, wherein the consumer is identified with a unique identification stored in a data farm device (Id. at page 8, lines 8-26), presenting an offer to the consumer on an offer display device, the offer based on information from the first transaction (Id. at page 9, lines 3-18), receiving an indication of acceptance of the offer from the consumer at the first merchant location (Id. at page 9, lines 19-20), associating the indication of acceptance with the unique identification of the consumer (Id. at page 9, lines 24-28), identifying the consumer using a further data capture device at a second merchant location where the consumer presents the instrument during the processing of a second transaction (Id. at page 10, lines 1-6), and retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction. (Id.).

The subject matter of independent claim 46 comprises a method including the

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steps of receiving consumer identification data from a data capture device at a merchant location where a consumer presents an instrument during processing of a transaction (Id. at page 8, lines 8-26), identifying a unique consumer identification record based on the consumer identification data, the unique consumer identification record stored in a data farm device (Id.), receiving transaction data from the transaction (Id. at page 9, lines 3-18), retrieving an offer based on the transaction data (Id.), sending the offer to an offer display device at the merchant location (Id.), receiving an indication of acceptance of the offer from the consumer at the merchant location (Id. at page 9, lines 19-20), and associating the indication of acceptance with the unique consumer identification record. (Id. at page 9, lines 24-28).

6. Grounds of Rejection to be Reviewed on Appeal

- I. Whether claims 30-49 are unpatentable under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,055,573 to Gardenswartz et al. ("the Gardenswartz patent").

7. Argument

- I. The Rejection of Claims 30-49 Under 35 U.S.C. § 102(e) as Being Anticipated By U.S. Patent No. 6,055,573 to Gardenswartz Should Be Reversed.

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A. The Examiner's Rejection

In the Final Office Action, the Examiner rejected claims 30-49 under 35 U.S.C.

102(e) as anticipated by the Gardenswartz patent. (See 1/17/06 Office Action, ¶ 2). The Gardenswartz patent describes a system for delivering a targeted advertisement to a consumer. (See the Gardenswartz patent, Abstract). A customer is provided with a customer identification (CID), which allows a store to record purchase data for the customer when the CID is presented at checkout. (Id. at col. 5, lines 44-64). Each customer is assigned a purchase behavior classification based on the customer's offline purchase history (e.g., not through merchant websites). (Id. at col. 10, lines 17-23). Targeted advertisements, based on the purchase behavior classification, are transmitted to a personal computer used by the customer. (Id. at col. 10, lines 23-28). One type of targeted advertisement described by the Gardenswartz patent is a value contract. (Id. at col. 14, lines 50-51). According to the value contract, "the consumer is offered a reward for complying with a particular behavioral pattern such as a predefined change in behavior or the continuance of an established behavior." (Id. at col. 14, lines 51-55). For example, "in order for a consumer to fulfill a value contract and receive a reward, the consumer may be required to purchase a preselected amount of a specified product within a predetermined amount of time." (Id. at col. 15, lines 8-12). Thus, the customer only enters into the value contract if he/she performs according to its term.

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- B. The Cited References Do Not Disclose Receiving an Indication of Acceptance of the Offer From the Consumer at the First Merchant Location and Retrieving the Offer Based on the Identification of the Consumer at the Second Merchant Location, Wherein the Offer is Applied to the Second Transaction as Recited in Claim 30.

The Examiner stated in the Final rejection that the Gardenswartz patent discloses the steps of “receiving an indication of acceptance of the offer from the consumer at the first merchant location” and “retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction.” (See 1/17/06 Office Action, ¶ 2). The Examiner reaffirmed this position in the Advisory Action of April 10, 2006. (See 4/10/06 Advisory Action, ¶ 2). Specifically, the Examiner stated that Gardenswartz allows a consumer to redeem a reward presented at a first location by visiting a specified location, which may also be the first location. (Id.). The Examiner supports this contention by stating that the language of claim 30 purportedly fails to specify that the first merchant location and the second merchant location are separate and distinct. (Id.). Thus, the Examiner’s contention is based on the premise that the first merchant location may be the same as the second merchant location.

Although claim 30 does not explicitly state that the first merchant location is separate from the second merchant location, the language recited clearly distinguishes the two locations by associating each location with a different merchant (i.e., first and second merchants). Because the first merchant and the second merchant are separate entities, it follows that the first merchant location must be “separate and distinct” from the second merchant location. Thus, the

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scenario which the Examiner has applied to the Gardenswartz patent, where the first retail location and the second retail location are the same, is not analogous to the limitations recited in claim 30.

A further distinction between the present invention as recited in claim 30 and the Gardenswartz patent lies in the manner in which offers are redeemed. In order to accept the reward, the consumer may have to visit a specified retail location. (See the Gardenswartz patent, col. 16, lines 39-42). The teachings of the Gardenswartz patent require the reward to be redeemed during a subsequent visit, regardless of whether the specified location is the first location or a different location. In contrast, the present invention as recited in claim 30 specifies that the consumer must accept the offer during a first transaction at the first merchant location. By associating the indication of acceptance with the unique identification of the consumer, the offer can be applied during a subsequent transaction. Without the explicit consent of the consumer, the offer cannot be applied.

While the Gardenswartz patent updates the consumer's records after the reward is redeemed for the purpose of determining future rewards, no mention or suggestion is made of "associating the indication of acceptance with the unique identification of the consumer" prior to redeeming the reward. This is because the Gardenswartz patent teaches automatically applying the reward during the subsequent transaction. After determining that conditions of the reward have been fulfilled, the reward is immediately presented to the consumer without consent. (Id. at col. 16, lines 29-38). The consumer is not given any chance to accept the reward, which is

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presented only if the reward conditions happen to be fulfilled while the consumer is engaged in a transaction at the specified location. The consumer does not announce his intention to redeem the reward and may even trigger the reward conditions inadvertently while engaged in normal consumer behavior such as shopping for items that the consumer regularly purchases. Thus, visiting the specified retail location is insufficient to indicate an acceptance of the reward. Therefore, it is respectfully submitted that the Gardenswartz reference neither discloses nor suggests "receiving an indication of acceptance of the offer from the consumer at the first merchant location" and "retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction," as recited in claim 30.

Therefore, at least for these reasons, it is respectfully submitted that claim 30 is allowable. The Appellant respectfully requests that the Board overturn the Examiner's rejection under 35 U.S.C. 102(e) of independent claim 30 and all the claims depending directly or indirectly therefrom (claims 31-36).

Independent claim 37 was also rejected under 35 U.S.C. § 102(e) as anticipated by the Gardenswartz patent. Claim 37 recites "an offer display device which receives the one of the offers from the data farm, displays the one of the offers to the consumer, receives an indication of acceptance of the one of the offers from the consumer and forwards the indication of acceptance to the data farm device, wherein the data farm device stores the indication of acceptance in the unique identification record of the consumer." Thus, claim 37 contains substantially the same

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limitations as claim 30.

Therefore, at least for the reasons stated above with regard to claim 30, it is respectfully submitted that claim 37 is allowable. Appellants respectfully submit request that the Board overturn the Examiner's rejection under 35 U.S.C. § 102(e) of independent claim 37 and all the claims depending directly or indirectly therefrom (claims 38-45).

Independent claim 46 was also rejected under 35 U.S.C. § 102(e) as anticipated by the Gardenswartz patent. Claim 46 recites "sending the offer to an offer display device at the merchant location" and "receiving an indication of acceptance of the offer from the consumer at the merchant location" and "associating the indication of acceptance with the unique consumer identification record." Thus, claim 46 contains substantially the same limitations as claim 30.

Therefore, at least for the reasons stated above with regard to claim 30, it is respectfully submitted that claim 46 is allowable. Appellants respectfully submit request that the Board overturn the Examiner's rejection under 35 U.S.C. § 102(e) of independent claim 46 and all the claims depending directly or indirectly therefrom (claims 47-49).

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9. Conclusions

For the reasons set forth above, the Appellant respectfully requests that the Board reverse the final rejections of the claims by the Examiner under 35 U.S.C. § 102(e) and indicate that claims 30-49 are allowable.

Respectfully submitted,

Date: June 26, 2006

By: 

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CLAIMS APPENDIX

1 - 29. (Canceled)

30. A method, comprising:

identifying a consumer using a data capture device at a first merchant location where the consumer presents an instrument during a processing of a first transaction at the first merchant, wherein the consumer is identified with a unique identification stored in a data farm device;

presenting an offer to the consumer on an offer display device, the offer based on information from the first transaction;

receiving an indication of acceptance of the offer from the consumer at the first merchant location;

associating the indication of acceptance with the unique identification of the consumer;

identifying the consumer using a further data capture device at a second merchant location where the consumer presents the instrument during the processing of a second transaction; and

retrieving the offer based on the identification of the consumer at the second merchant location, wherein the offer is applied to the second transaction.

31. The method of claim 30, wherein the instrument is one of a credit card, a debit card and a customer loyalty card.

32. The method of claim 30, wherein the offer is a discount on merchandise.

33. The method of claim 30, wherein the second merchant location is independent from the first merchant location.

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34. The method of claim 30, wherein the information from the first transaction includes an identification of a purchased product.

35. The method of claim 30, further comprising the step of:
disassociating the indication of acceptance with the unique identification when the consumer completes the second transaction.

36. The method of claim 30, further comprising the step of:
disassociating the indication of acceptance with the unique identification when the second transaction is incomplete after expiration of a predetermined period of time.

37. A system, comprising:
a data capture device capturing consumer identification data at a merchant location where a consumer presents an instrument during a processing of a transaction and transaction data from the transaction;
a data farm device including a unique identification record for the consumer and a plurality of offers, the data farm device receives the consumer identification data to uniquely identify the consumer, and the transaction data, wherein the data farm device selects one of the offers based on the transaction data; and
an offer display device which receives the one of the offers from the data farm, displays the one of the offers to the consumer, receives an indication of acceptance of the one of the offers from the consumer and forwards the indication of acceptance to the data farm device, wherein the data farm device stores the indication of acceptance in the unique identification record of the consumer.

38. The system of claim 37, wherein the data capture device and the offer display device are physically located within a single merchant device.

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39. The system of claim 37, wherein the data capture device receives at least a portion of the transaction data from one of a cash register and a bar code reader.
40. The system of claim 37, wherein the data farm device is located remotely from the data capture device and receives the consumer identification data and the transaction data via a communications network.
41. The system of claim 40, wherein the communications network is one of an internet and an intranet.
42. The system of claim 37, wherein the instrument is one of a credit card, a debit card and a customer loyalty card.
43. The system of claim 37, wherein the data farm device is a server.
44. The system of claim 37, wherein the unique identification record is a database record.
45. The system of claim 37, further comprising:
a further data capture device capturing the consumer identification data at a further merchant location where the consumer presents the instrument during processing of a further transaction and further transaction data from the further transaction, wherein the data farm device receives the consumer identification data and further transaction data from the further data capture device, retrieves the one of the offers from the unique identification record based on the consumer identification data and the further transaction data and sends the offer to the further merchant location.
46. A method, comprising:

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receiving consumer identification data from a data capture device at a merchant location where a consumer presents an instrument during processing of a transaction;

identifying a unique consumer identification record based on the consumer identification data, the unique consumer identification record stored in a data farm device;

receiving transaction data from the transaction;

retrieving an offer based on the transaction data;

sending the offer to an offer display device at the merchant location;

receiving an indication of acceptance of the offer from the consumer at the merchant location; and

associating the indication of acceptance with the unique consumer identification record.

47. The method of claim 46, further comprising:

receiving the consumer identification data from a further merchant location where the consumer presents the instrument during processing of a further transaction;

identifying the unique consumer identification record based on the consumer identification data;

receiving further transaction data from the further transaction;

retrieving the offer having the indication of acceptance in the unique consumer identification, wherein the further transaction data includes information relating to the offer; and

sending the offer to the further merchant location.

48. The method of claim 47, wherein the offer is a discount on a product and the information in the further transaction data indicates the consumer is purchasing the product.

49. The method of claim 47, wherein the transaction data includes identification of a product purchased by the consumer in the transaction.

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EVIDENCE APPENDIX

No evidence has been submitted herewith or is relied upon in the present appeal.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings and/or decisions which relate to the present
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